

## **REMARKS**

### **I. Status of Claims**

No claims are amended in this paper. Claims 1-3, 5-13, 18, 19, 21, 24, 28, 32, 34, 35, and 40 remain pending, with claims 1-3, 5-11, 13, 18, 21, 24, 28, 32, and 34 under examination and claims 12, 19, 35, and 40 withdrawn from consideration.

The Office Action<sup>1</sup> sets forth the following:

- (a) claims 1-3, 5-11, 13, 18, 21, 24, 28, 32, and 34 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite (Office Action at 3);
- (b) claims 1-3, 5-11, 13, 18, 21, 28, 32, and 34 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,911,105 to Popantoniou et al. ("the '105 patent") (Id.); and
- (c) claims 1-3, 5-14, 18, 21, 24, 28, and 31-34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of the '105 patent and U.S. Patent No. 6,857,245 to Pavlin ("the '245 patent") (Id. at 6).

### **II. Examiner Interview**

Applicant thanks the Examiner for the time and courtesy extended in conducting a personal interview with Applicant's representatives on November 9, 2009 ("Interview"). During the Interview, the rejections set forth in the pending Office Action were discussed, as was the Declaration under 37 C.F.R. § 1.132 of Nathalie Jager Lezer dated March 13, 2009, ("the Jager Lezer Declaration") filed on April 9, 2009. Applicant

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

agrees with the Interview Summary in that no formal agreement was reached. The substance of the interview is made of record in this paper.

**III. Response to Office Action**

**A. Rejection under 35 U.S.C. § 112, second paragraph**

Applicant respectfully traverses the rejection of claims 1-3, 5-11, 13, 18, 21, 24, 28, 32, and 34 under 35 U.S.C. § 112, second paragraph as being indefinite. The Office Action rejects these claims for allegedly “being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.” Office Action at 3. In particular, the Office Action alleges that “[c]laim 1 is unclear and lacks clarity ... because the expression ‘thermal profile having a melting peak ...’ is repeated twice.” Id.

Applicant respectfully disagrees. As discussed in the Interview, claim 1 intentionally contains two recitations regarding the claimed thermal profile because both the composition and the polymer must have the claimed “thermal profile having a melting peak.” Paragraph [031] on page 6 of Applicant’s specification describes the claim language regarding the thermal profile. Also, independent claim 32 only recites language regarding a thermal profile once.

Applicant submits that independent claims 1 and 32, and claims 2, 3, 5-11, 13, 18, 21, 24, 28, and 34 which depend from claim 1 or claim 32, fully satisfy the requirements of 35 U.S.C. § 112, second paragraph. Applicant therefore respectfully

requests reconsideration and withdrawal of the rejection of claims 1-3, 5-11, 13, 18, 21, 24, 28, 32, and 34.

**B. Rejection under 35 U.S.C. § 102(b)**

Applicant respectfully traverses the rejection of claims 1-3, 5-11, 13, 18, 21, 28, 32, and 34 under 35 U.S.C. § 102(b) as being anticipated by the '105 patent for the reasons of record and for the following additional reasons.

In order to properly anticipate Applicant's claimed invention under 35 U.S.C. § 102, each and every element of the claim in issue must be "either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Moreover, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989)." See M.P.E.P. § 2131.

The Office Action alleges that the '105 patent teaches Applicant's elected species of one compound which gives the cosmetic composition a thermal profile -- polystearyl acrylate -- and asserts that the "PTO is not equipped to measure the thermal profile and the limitations claimed in claims 2-3 and 5-11, are also anticipated by patent '105." Office Action at 3.

Applicant respectfully disagrees. The "thermal profile" and "composition [being] heat-stable," recited in claim 1 are not inherent results of a composition comprising polystearyl acrylate and are not anticipated by the '105 patent. As discussed in the

Interview, Applicant filed the Jager Lezer Declaration on April 9, 2009, detailing the results of testing Compositions A and B, both of which were modeled after Example 29 of the '105 patent. Example 29 appears to be the closest prior art example in the '105 patent because it is drawn to a mascara composition ('105 patent, col. 14, lines 21-22) and the composition according to claim 1 is a mascara.

The Office Action alleges that the Jager Lezer Declaration "is insufficient to overcome the rejection of claims ... as set forth in the last Office action" and in support of this allegation sets forth five questions (shown in bold below) regarding the Declaration. Office Action at 5-6. Applicant's representatives provided responses to these questions in the Interview, and summarize their responses as follows:

**1. Applicant tested polystearyl acrylate-dimethicone methacrylate copolymer instead of polystearyl methacrylate of Example 8 of the '105 patent.**

- Polystearyl acrylate-dimethicone methacrylate copolymer was used because the '105 patent discloses the use of crosslinked polymers, such as in its Example 9. Thus the testing demonstrated that even if a crosslinked polymer is used, the compositions disclosed by the '105 patent are not necessarily heat stable.
- **2. Polyvinyl laurate was used instead of polyvinyl stearate for composition A.**
- Polyvinyl stearate is not readily available from Applicant's chemical suppliers and was not available at the time of the testing. However, polyvinyl laurate and

polyvinyl stearate have similar structures with polyvinyl laurate having a C12 chain and polyvinyl stearate having a C18 chain. Thus, Applicant submits a composition modeled after Example 29 of the '105 patent and comprising polyvinyl laurate would illustrate, as would a composition comprising polyvinyl stearate, that compositions of the '105 patent do not possess the heat stability of claim 1.

- **3. *The Office Action questions the amount of the first three ingredients in Compositions A and B.***
- Example 29 of the '105 patent discloses Fatty Composition P, which is 62.5% beeswax, 12.5% lanolin alcohol, 10% acetylated lanolin, and 15% homopolymer of Example 1 of the '105 patent. Fatty Composition P itself comprises 39% of the composition of Example 29.
- In the Jager Lezer Declaration, the first four ingredients of Compositions A and B are beeswax, lanolin alcohol, acetylated lanolin, and a polymer. The amounts of each of these for ingredients satisfy the percentage requirements set forth in Example 29.
- Composition A
  - beeswax  $(39g \times 62.5g) / 100 = 24.4g$
  - lanolin alcohol  $(39g \times 12.5g) / 100 = 4.9g$
  - acetylated lanolin  $(39g \times 10g) / 100 = 3.9g$

- polyvinyl laurate  $(39\text{g} \times 15\text{g}) / 100 = 5.8\text{g}$

Composition B

- beeswax  $(39\text{g} \times 62.5\text{g}) / 100 = 24.4\text{g}$
  - lanolin alcohol  $(39\text{g} \times 12.5\text{g}) / 100 = 4.9\text{g}$
  - acetylated lanolin  $(39\text{g} \times 10\text{g}) / 100 = 3.9\text{g}$
  - polystearyl acrylate – dimethicone methacrylate copolymer  $(39\text{g} \times 15\text{g}) / 100 = 5.8\text{g}$
- 4. *What is the physiologically accepted medium in Example 29?***
  - Applicant does not believe a physiologically acceptable medium must be identified, because Applicant merely prepared the composition disclosed by the '105 patent in Example 29. Nevertheless, the fatty composition (beeswax, lanolin alcohol, acetylated lanolin, and polymer) appears to be the physiologically acceptable medium in Example 29.
  - 5. *Examples 29 and 30 are drawn to anhydrous mascara, but example 1 of Applicant's specification uses water. The closest prior art in patent '105 are also examples 26-28, which use water.***
  - Only Example 29 of the '105 patent uses polystearyl methacrylate and is a mascara, and thus (as noted above) would be the closest Example in the '105 patent. Using Examples 26-28, which do not use polystearyl methacrylate, would further underscore the point that the heat stability of a composition is not an inherent property.

In the Interview, the Examiner suggested that Applicant perform additional comparative testing by preparing the composition of Example 29 of the '105 patent, but using polystearyl acrylate instead of the "homopolymer of Example 1." '105 patent, col. 14 line 34. The Examiner suggested that Applicant then evaluate the heat stability of such a composition.

In response, Applicant has performed comparative testing per the Examiner's suggestion and submit herewith a Declaration under 37 C.F.R. § 1.132 of Florence LAHOUSSE dated December 16, 2009 ("the LAHOUSSE Declaration"), describing the testing. As set forth in the LAHOUSSE Declaration, a composition according to Example 29 of the '105 patent, but using polystearyl acrylate instead of the "homopolymer of Example 1," was evaluated for heat stability using the procedure described in Applicant's specification at paragraph [0156] on page 38. See the LAHOUSSE Declaration at ¶¶ 8-10 and Table 1. The LAHOUSSE Declaration shows that a composition of Example 29, including polystearyl acrylate, does not possess the heat stability of claim 1. See id. at ¶¶ 14-15 and Table 2. Thus, the LAHOUSSE Declaration demonstrates that the heat stability of claim 1 is not an inherent result of a composition comprising polystearyl acrylate and is not anticipated by the '105 patent. For at least this reason, independent claim 1 should be allowable over the '105 patent. Independent claim 32 differs in scope from claim 1 but also recites that "the cosmetic composition is heat-stable," and should be allowable over the '105 patent for reasons similar to those presented above regarding claim 1. Claims 2, 3, 5-11, 13, 18, 21, 28,

and 34 which depend from claim 1 or claim 32 should also be allowable. Applicant therefore respectfully requests withdrawal of the rejection of claims 1-3, 5-11, 13, 18, 21, 28, 32, and 34

**C. Rejection under 35 U.S.C. § 103(a)**

Applicant respectfully traverses the rejection of claims 1-3, 5-14, 18, 21, 24, 28, and 31-34 under 35 U.S.C. § 103(a) as being unpatentable over the combination of the '105 patent and the '245 patent for the reasons of record and for the following additional reasons. See Office Action at 6. This rejection is rendered moot with respect to withdrawn claim 12 and cancelled claims 14, 31, and 33.

Determining the obviousness of a claimed invention under 35 U.S.C. § 103 requires that the Office apply three factual inquiries, which were originally outlined in *Graham v. John Deere Co.*, and reaffirmed in *KSR International Co. v. Teleflex, Inc.* See *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966); *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 82 USPQ2d 1385 (2007) ("...the [*Graham*] factors continue to define the inquiry that controls."). Accordingly, in order to establish a *prima facie* case of obviousness, the Office must objectively perform each of the following factual inquiries:

- (A) Ascertain the scope and contents of the prior art;
- (B) Ascertain the differences between the claimed invention and the prior art; and
- (C) Resolve the level of ordinary skill in the pertinent art.

See *Graham* 383 U.S. 1 at 17-18; see also M.P.E.P. § 2141. The obviousness or non-obviousness of the claimed invention is then evaluated in view of the results of these



inquiries. *Graham*, 383 U.S. at 17-18, 148 U.S.P.Q. at 467; *see also* KSR, 127 S. Ct. at 1734, 82 U.S.P.Q.2d at 1391.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reasons why the claimed invention would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. *See* M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). "A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention." M.P.E.P. § 2145. Furthermore, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" at the time the invention was made. M.P.E.P. §2143.01(III), internal citation omitted. Moreover, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

The Office Action has not established a *prima facie* case of obviousness. As established above, the '105 patent does not inherently anticipate independent claim 1. The '105 patent also does not teach or suggest the subject matter of independent claim 1. This is at least because the '105 patent does not teach or suggest

[a] cosmetic composition comprising, in a physiologically acceptable medium, at least one compound which gives the cosmetic composition a thermal profile having a melting peak wherein the mid-height width Lf is less than or equal to 20°C, the at least one compound having a thermal profile having a melting peak wherein the mid-height width Lf is less than or equal to 20°C ... **wherein the cosmetic composition is heat-stable**

as recited in independent claim 1 (emphasis added).

First, the '105 patent does not disclose or suggest that the compositions it discloses are heat-stable or that heat-stability is an objective of the '105 patent. Second, as shown in the LAHOUSSE Declaration, compositions disclosed by the '105 patent are not inherently heat stable. Nor is heat stability a predictable result of compositions that comprise polystearyl acrylate.

In addition, one of ordinary skill in the art at the time of the present invention would not have considered it obvious to modify the '105 patent in an attempt to achieve a composition that was heat-stable or to achieve Applicant's claimed invention. This is at least because, as established above, the '105 patent does not disclose or suggest that any composition it discloses is heat stable. Further, in view of the LAHOUSSE Declaration, the '105 patent does not render obvious heat stability. For at least these reasons, the '105 patent does not teach or suggest Applicant's claimed invention as recited in independent claim 1.

The '245 patent is relied upon for its alleged disclosure of gum arabic. Id. Without acceding to this allegation, Applicant submits that the '245 patent does not overcome the deficiencies of the '105 patent, at least because the '245 patent does not

disclose or suggest a cosmetic composition that is heat-stable, as required by independent claim 1. For at least this reason, the '105 patent, even if combined with the '245 patent, does not disclose or suggest Applicant's claimed invention as recited in independent claim 1.

Independent claim 1 should therefore be allowable over the '105 patent and the '245 patent. Independent claim 32 differs in scope from claim 1 but also recites that "the cosmetic composition is heat-stable." Independent claim 32 should be allowable at least for reasons similar to those presented above regarding claim 1. Claims 2, 3, 5-11, 13, 18, 21, 24, 28, and 34 which depend from claim 1 or claim 32 should also be allowable. Applicant therefore respectfully requests reconsideration and withdrawal of the rejection of claims 1-3, 5-11, 13, 18, 21, 24, 28, 32, and 34.

**IV. Conclusion**

In view of the foregoing remarks, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

The undersigned may be contacted with any questions or comments.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: December 17, 2009

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**Attachment:** Declaration under 37 C.F.R. § 1.132 of Florence LAHOUSSE.